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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/271,581

Applicant(s)

RAO ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 28 August 2003 have been fully considered but they are not persuasive. Applicant's argument that the Kubota reference does not disclose installing software onto a computer system wherein the computer system contains manufacturer specific identification information identifying the computer system manufacturer, and using a key to ensure the software is installed only on a computer system manufactured by the computer system manufacturer because Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45).

2. Applicant's argument that the Kubota and Patterson reference does not teach storing the key in a registry file is not persuasive because Patterson discloses a system to regulate access to digital content where on the Windows Operating System a registry file is used to store the unique coded key (Col. 3, lines 54-56), and the use of CD-ROM (Col. 3, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the key taken from the configuration file in Kubota in a registry file in order to lock the installed object to that particular machine as taught in Patterson (Col. 3, lines 56-63).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5, 10, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubota, U.S. Patent No. 5,034,980. Referring to claims 1, 5, 10, 13, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45). Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Charabaszcz, U.S. Patent No. 6,363,497. Referring to claims 2,

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11, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45).

Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Kubota does not disclose a BIOS memory file included in the configuration file. Charabaszcz discloses a primary server that calls a backup server to read the BIOS or configuration files when the primary server goes down (Col. 12, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a BIOS memory file with the configuration file of Kubota in order to have both the BIOS file and configuration file information together for system reset purposes as taught in Charabaszcz (Col. 12, lines 61-65).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Charabaszcz, U.S. Patent No. 6,363,497 as applied to claim 2 above, and further in view of Dollahite, U.S. Patent No. 5,748,877. Referring to claim 3, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic

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code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45). Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Charabaszcz does not disclose a BIOS memory file stored on a nonvolatile memory. Dollahite discloses a BIOS memory file stored on an electrically erasable programmable read-only memory (EEPROM) (Col. 3, lines 3-9), which by definition is nonvolatile. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a BIOS memory file stored on an EEPROM in the technique for mass distribution of software of Kubota in order to save the state of the PC to a hard disk for resetting purposes as taught in Dollahite (Col. 1, line 63- Co. 2, line 5).

8. Claims 4, 8, 12, 16, 18, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541. Referring to claims 4, 8, 12, 16, 20, and 22, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45). Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Kubota

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does not disclose storing the key in a registry file that is stored on a nonvolatile storage device.

Patterson discloses a system to regulate access to digital content where on the Windows

Operating System a registry file is used to store the unique coded key (Col. 3, lines 54-56), and the use of CD-ROM (Col. 3, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the key taken from the configuration file in Kubota in a registry file in order to lock the installed object to that particular machine as taught in Patterson (Col. 3, lines 56-63).

9. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Cooper, U.S. Patent No. 5,757,904. Referring to claims 6 and 14, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45).

Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Kubota does not disclose checking the authenticity of the key taken from the configuration file. Cooper discloses a method for providing distributed software where the decryption key provided by the software vendor is authenticated (Col. 15, lines 42-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to authenticate the key used in the technique for mass distribution of

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software of Kubota in order to inform the user-controlled system that the key taken from the configuration file is authentic as taught in Cooper (Col. 15, lines 54-60).

10. Claims 7 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Pearce, U.S. Patent No. 5,694,582. Referring to claims 7 and 15, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45).

Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Kubota does not disclose the reading and determining program being stored in a dynamic linked library. Pearce discloses an operating system that loads an executable file for execution and replaces references with addresses that are valid for usage in function calls. A dynamic link library is a module that satisfies these references by dynamic linking (Col. 5, lines 10-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the program that reads the configuration file and determines the key to be stored in a dynamic linked library in order to provide runtime support code that is linked to an executable file as taught in Pearce (Col. 5, lines 3-5).

11. Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Saxena, U.S. Patent No. 6,259,449. Referring to claims 9

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and 17, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45).

Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Kubota does not disclose storing data on a Web Page accessible to a global computer network. Saxena discloses a web server that stores data in the form of web pages and transmits these pages as Hypertext Markup Language (HTML) files over the Internet network to a host computer (Col. 3, lines 37-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store data from the nonvolatile storage devices in Kubota as web pages so that the data is accessible over the Internet through a web browser as taught in Saxena (Col. 3, lines 41-46).

12. Claims 19 and 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541 as applied to claims 18 and 20 above, and further in view of Charabaszcz, U.S. Patent No. 6,363,497. Referring to claims 19 and 21, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular

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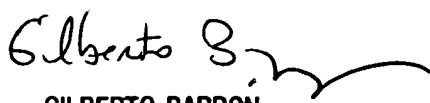
microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45). Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Patterson discloses a system to regulate access to digital content where on the Windows Operating System a registry file is used to store the unique coded key (Col. 3, lines 54-56). Patterson does not disclose a BIOS memory file included in the configuration file. Charabaszcz discloses a primary server that calls a backup server to read the BIOS or configuration files when the primary server goes down (Col. 12, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a BIOS memory file with the configuration file of Kubota in order to have both the BIOS file and configuration file information together for system reset purposes as taught in Charabaszcz (Col. 12, lines 61-65).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



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